

200312102-1

10/789,963

REMARKS

This is a full and timely response to the non-final Official Action mailed August 11, 2006. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

As indicated in the Summary of the recent Office Action, claims 26-45 and 59-70 were withdrawn from consideration under a previous Restriction Requirement. To expedite prosecution of this application, claims 26-45 and 59-70 have been cancelled herein without prejudice or disclaimer. Applicant reserves the right to file any number of continuation or divisional applications to the withdrawn claims or to any other subject matter described in the present application.

Claims 11-25, 46, 47 and 50 were cancelled previously without prejudice or disclaimer.

The recent Office Action provides an examination of claims 48, 49 and 51-58 which will be discussed below.

Claim 1-10 are unaccounted for. No rationale has been advanced on the record for restricting claims 1-10, as currently presented, from the elected subject matter. Therefore, an examination of claims 1-10 should apparently have been conducted.

By the present amendment, new claims 71-79 are added. Thus, claims 1-10, 48, 49, 51-58 and 71-79 are currently pending for further action.

200312102-1

10/789,963

35 U.S.C. § 112, Second Paragraph:

The recent Office Action rejected claim 58 under 35 U.S.C. § 112, second paragraph, due to the inclusion of tradenames. Accordingly, Applicant has amended claim 58 herein to remove the previously recited tradenames. Therefore, following entry of this amendment, the rejection under § 112 should be reconsidered and withdrawn.

Additionally, the Office Action also requested clarification of the recitation of in claim 58 of "ester of ethylene glycol ...". In response, "ester of" appears to refer only to ethylene glycol and not to subsequent listings. Applicant believes this is clear from the grammar and punctuation used.

Prior Art:

Claims 48, 49 and 51-56 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent App. Pub. No. 2002/0155260 to Chen et al. ("Chen"). This rejection is respectfully traversed for at least the following reasons.

A microporous coating comprising:
a first microporous layer comprising a first binder; and
a fusible latex layer deposited over said first microporous layer, wherein said fusible latex layer is microporous and includes particles comprising a hard core material and a soft shell material;
wherein said latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and without being fused.

In contrast, Chen does not teach or suggest the claimed fusible latex layer deposited over a microporous layer comprising a binder. Chen further does not teach or suggest that the "latex exhibits self-adhesive properties at a room temperature such that said latex layer remains in place on said first microporous layer without requiring a second binder and *without being fused.*" (Emphasis added).

200312102-1

10/789,963

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection based on Chen should be reconsidered and withdrawn.

Claim 49 recites: "The microporous coating of claim 48, wherein said latex layer is for forming an ink permeable and permits the transmission of ink through said latex layer to said first microporous layer prior to said fusible latex layer being fused." In contrast, Chen does not teach or suggest transmitting ink through a latex layer to an underlying microporous layer prior to the fusible latex layer being fused. For at least this additional reason, the rejection of claim 49 should be reconsidered and withdrawn.

Claim 51 recites "The microporous coating of claim 49, wherein, after a printing process in which ink has passed through said latex layer, said latex is for forming a fused, continuous transparent film by the application of thermal energy or pressure." In contrast, Chen does not teach or suggest that after a printing process in which ink has been passed through a latex layer, the latex is for forming a fused, continuous transparent film by the application of thermal energy or pressure. For at least this additional reason, the rejection of claim 51 should be reconsidered and withdrawn.

Claim 54 recites:

A microporous coating comprising:
a fusible latex, wherein said fusible latex includes particles comprising a hard core material and a soft shell material;

200312102-1

10/789,963

wherein said soft shell material comprises one of tetrahydrofurfuryl acrylate, cyclohexylacrylate, iso-decylacrylate, n-decylmethacrylate, vinylacetate, 2-(N,N-Dimethylamino)ethyl methacrylate, 2-N-Morpholinoethyl acrylate, or 3-Dimethylaminoneopentyl acrylate.

In contrast, Chen does not teach or suggest these materials used as a soft shell material surrounding a hard core material of a fusible latex microporous coating. Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least these reasons, the rejection of claim 54 based on Chen should be reconsidered and withdrawn.

The recent Office Action also alternatively rejected claims 48, 49 and 51-57 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 6,375,320 to Chu et al. ("Chu"). This patent is by two of the same inventors as the Chen reference described above and teaches substantially the same subject matter. Consequently, the rejection based on Chu should be reconsidered and withdrawn for the same reasons given above with respect to the rejection based on Chen.

In yet another alternative rejection, claims 48, 49 and 51-58 were rejected as obvious under 35 U.S.C. § 103(a) over the teachings of Chen or Chu in view of any of several secondary references. According to the Office Action, these secondary references are cited for their teachings regarding coalescing agents.

Consequently, the cited secondary references are not alleged to, and do not, remedy any of the deficiencies of the Chen or Chu references noted above. Consequently, the

200312102-1

10/789,963

rejection under § 103(a) should also be reconsidered and withdrawn for the same reasons given above with respect to the rejections based on Chen and Chu.

Finally, the Office Action makes another alternative rejection of claims 48, 49, 51-54 and 57 under either § 102(b) or § 103(a) in view of the teachings of U.S. Patent No. 4,497,917 to Upson et al. ("Upson"). This rejection is respectfully traversed for at least the following reasons.

Upson is an early patent owned by the same company that sponsored the work of Chen and Chu above. Accordingly, the teachings of Upson fail to anticipate or render obvious the claims for at least the same reasons given above with regard to the teachings of Chen and Chu.

200312102-1

10/789,963

Conclusion:

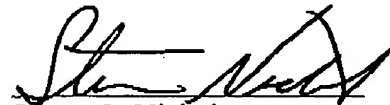
The newly added claims are thought to be patentable over the prior art of record for at least the same reasons given above with respect to the original independent claims.

Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: November 10, 2006

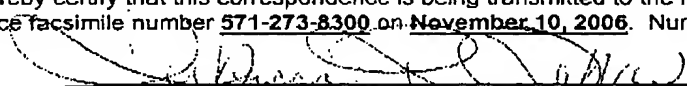

Steven L. Nichols
Registration No. 40,326

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number **571-273-8300** on **November 10, 2006**. Number of Pages: **17**


Rebecca R. Schow